

REMARKS

Entry of the foregoing and reconsideration of the subject application are respectfully requested in light of the amendments above and the comments which follow.

As correctly noted in the Office Action Summary, claims 1, 3, 4, 11 and 14 were pending. By the present response, claim 3, 4 and 14 have been amended to improve the form of the claims. Thus, upon entry of the present response, claims 1, 3, 4, 11 and remain pending and await further consideration on the merits.

Support for the foregoing amendments can be found, for example, in at least the following locations in the original disclosure: the original claims.

CLAIM REJECTIONS UNDER 35 U.S.C. §112

Claims 1, 3, 4, 11 and 14 stand rejected under 35 U.S.C. §112, second paragraph, on the grounds set forth on page 2 of the Official Action. Applicant has previously amended claim 1 in a manner which addresses the above-noted rejection. The following remarks are presented.

Specifically, claim 1 recites the distinctions and differences between the first and second mold patterns. For example, function holes and function recesses are defined in the first digital mould pattern, and a product cavity and a parting plane of the mould are defined, separate from and parallel to the step of defining the function holes and function recesses, in the second digital mould pattern. The advantages and distinctions of this feature are discussed in the specification, beginning at page 2, line 24.

Furthermore, claim 1 clarifies the claimed method for making an injection mould by specifically reciting the step of machining the first mould half and the second mould half using said digital information in an NC machine. As previously submitted, Applicant submits this step only in response to the Examiner's comment that independent claim 1 is incomplete because "there is no injection mould formed as a result of performing the claim steps." Nevertheless, Applicant respectfully submits that the claimed method includes the transitional phrase "comprising" and therefore does not exclude additional, unrecited method steps. Therefore, Applicant submits that it should not be necessary to actually recite the method step of machining since the claimed method is recited in an open-ended format. In order to expedite prosecution and advance this case to issuance, Applicant has added the claim step of machining in response to the Examiner's comment that independent claim 1 is incomplete.

Additional minor amendments to the claims have been submitted to place the claims in better form.

Reconsideration and withdrawal of the rejection is respectfully requested.

CLAIM REJECTIONS UNDER 35 U.S.C. §103

Claims 1, 3, 4 and 14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,595,771 to Foltuz et al. (hereafter "*Foltuz et al.*") in view of U.S. Patent No. 4,795,125 to Boros et al. (hereafter "*Boros et al.*") on the grounds set forth beginning on page 2 of the Official Action. For at least the following reasons, this rejection should be withdrawn.

Claim 1, the only independent claim at issue here, recites that a method for making an injection mould, including a first mould half and a second mould half, comprises the steps of, *inter alia*, receiving, in a computer based system, digital information relating to a shape of a product pattern, placing digital information relating to the shape of the product pattern into a first digital mould pattern and into a second digital mould pattern, respectively, wherein the first digital mould pattern represents both the first mould half and the second mould half and wherein the second digital mould pattern represents both the first mould half and the second mould half, defining function holes and function recesses in the first digital mould pattern, defining, separate from and parallel to the step of defining function holes and function recesses, a product cavity and, a parting plane of the mould in the second digital mould pattern; and machining said first mould half and said second mould half using said digital information in an NC machine.

This rejection is respectfully traversed because a *prima facie* case of obviousness has not been established. Specifically, the combination of the disclosure in *Foltuz et al.* and *Boros et al.* does not teach or suggest all of the claim limitations. See, MPEP §2143.

Foltuz et al. discloses a mold assembly 10 generally comprising a plurality of sections, with a fixed side 12 and an injector side 14. Mold inserts 55b, 55d, 55e, and 55f are used in forming a mold component 100. The plurality of interchangeable modules allow for the shaping of a plurality of sides of a component.

There is no disclosure in *Foltuz et al.* of a method for actually making an injection mold or mold inserts. Rather, *Foltuz et al.* discloses use of injection molds or mold inserts to shape a plurality of sides of a component.

Boros et al. is relied upon in the Office Action for allegedly disclosing an injection mold assembly for a computer-based system. Thus, the Office Action is merely relying upon the disclosure in *Boros et al.* for making injection molds in a computer-based system comprising digital information.

However, the combination of the disclosure in *Foltuz et al.* and *Boros et al.* does not teach or suggest all of the claim limitations. Specifically, the combination does not disclose a method for making an injection mold as claimed in independent claim 1. Indeed, the combination of the disclosures relied upon in the Official Action does not disclose a method for making an injection mold but merely discloses, at best, the use of an injection mold.

For at least the above-noted reason, the Official Action has failed to establish a *prima facie* case of obviousness and the rejection should be withdrawn. See MPEP §2143.

Furthermore, the rejection should be withdrawn because it improperly relies upon the doctrine of inherency.

The Official Action dated December 23, 2003 and the Advisory Action dated March 9, 2004 referencing the earlier Official Action, refers to column 5, lines 3-7 of *Foltuz et al.* and states that it is inherent that a product pattern be received in order for the location and sizes of the holes, recesses, and cavities to be defined. The Official Action also further relies upon inherency in finding that *Foltuz et al.* discloses defining a coordinate system with respect to claim 3. See the Official Action dated December 23, 2003 on page 3. In addition, since the combination of references cited in the Official Action do not teach or suggest all the claim limitations, it appears that the Examiner is also relying upon the doctrine of inherency to find the disclosed

injection mold of *Foltuz et al.* as inherently disclosing a method for making an injection mold as presently claimed.

The Examiner has clearly incorrectly applied the doctrine of inherency. In order for a claimed element to be "inherent" in a prior art reference, the claimed element or feature must necessarily result from the prior art. "Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Furthermore, inherency "may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Continental Can Co., U.S.A. v. Monsanto Co., 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991).

In other words, for the claimed method for making an injection mould to be inherent in the combination of *Foltuz et al.* and *Boros et al.*, every mould assembly in the cited references must rely upon the claimed method of making an injection mould. It is not sufficient that a disclosed mould that meets the description set forth in the *Foltuz et al.* and *Boros et al.* disclosures may have resulted from the claimed method. See, In re Rijckaert, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993). ("The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency.")

Although a mould consistent with the teachings of *Foltuz et al.* and *Boros et al.* may result from the method set forth in claim 1 of the present application, there is no reason based on the teachings of *Foltuz et al.* and *Boros et al.* that such a mould must necessarily result. Accordingly, the claimed method is not inherent in the *Foltuz et al.* and *Boros et al.* references. The rejection set forth by the Examiner is

based on an incorrect understanding of the doctrine of inherency. Thus, the rejection must be withdrawn.

Claim 11 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Foltuz et al.* as presented beginning on page 4 of the Official Action. Claim 11 depends from claim 1 is improperly rejected over the disclosures in *Foltuz et al.* and *Boros et al.* for at least the same reasons as noted above with respect to independent claim 1. Withdrawal of the rejection is respectfully requested.

CONCLUSION

From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

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